

REMARKS

Introduction

The present application includes claims 1-30, wherein claims 1, 7, 10, 11, 15, 18, 21, and 27 are presented in independent form. Applicants acknowledge with appreciation the Examiner's indication that claims 27-30 contain allowable subject matter. Reconsideration and reversal of the rejection of claims 1-27 presented in the Office Action dated October 8, 2004 is respectfully requested in light of the following amendments and arguments.

Specification

The specification was amended to clarify terms. All the disclosure was provided by the figures. No new matter was added.

Additionally, claim 7 was amended to use the term channel instead of corridor. This change was to provide proper antecedent basis for the term. Therefore, the examiner's objection to the specification is now moot. The change provides no new matter.

Prior Art Rejections

The Examiner has rejected claims 1, 4, 5, 21 and 22 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,279,795 to Pierzina (hereinafter "Pierzina"). The Examiner rejected claims 1-3, 5-12, 14, 15, 19-26 under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Application JP 10-266510 (hereinafter "Japanese Application"). The Examiner rejected claims 13 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Application in view of U.S. Patent No. 5,875,792 to Campbell, Jr. et al. (hereinafter Campbell).

§ 102(e) in view of Pierzina

Applicants respectfully submit that the Pierzina patent simply does not support the Examiner's rejection of claims 1, 4, 5, 21 and 22 under 35 U.S.C. § 102(e) in light of the arguments and amendments made in this response. The case law clearly states that "anticipation requires that a single prior art reference disclose every limitation of the patent claim." General Electric Co. v. Nintendo Co., 50 USPQ2d 1910, 1915 (Fed. Cir. 1999) (citing PPG Industries, Inc. v. Guardian Industries Corp., 37 USPQ2d 1618, 1624 (Fed. Cir. 1996)) ("to anticipate a claim, a reference must disclose every element of the challenged claims and enable one skilled in the art to make the anticipating subject matter."). More particularly, the Federal Circuit has held that the test for anticipation is "[t]hat which would literally infringe if later in time anticipates if earlier than the date of invention." Lewmar

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Marine, Inc. v. Bariant, Inc., 827 F.2d 744, 3 USPQ2d 1776 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

Pierzina describes a sling 10 for a gun 12. Sling 10 includes a body of padding material 24 having a flexible flat strap member 14 embedded therein. Flexible strap member 14 includes connectors 16 and 18 to connect sling 10 to gun 12. A plurality of elongated indentations 34 and 36 extend into opposite sides of padding material 24 and indentations 34 on one side of the padding material are offset longitudinally with respect to indentations 36.

Claim 1

Pierzina fails to teach or suggest a combination including "a patient support surface, and a siderail having a siderail covering comprising a flexible body having a plurality of notches defined in the body..." as required by amended claim 1. Pierzina does not include a patient support surface as required by amended claim 1. Pierzina relates to a gun strap and does not disclose, teach or suggest a patient support surface as recited by amended claim 1.

Therefore, Applicants believe that amended claim 1 is in condition for allowance with respect to Pierzina. Removal of the rejection and allowance of claim 1 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

Claims 4 and 5

Claims 4 and 5 depend from claim 1. In that claim 1 is believed to be allowable, claims 4 and 5 are also believed to be allowable. Removal of the rejections and allowance of claims 4 and 5 is respectfully requested.

Claim 21

Pierzina fails to teach or suggest a combination including "a patient support surface; and a siderail including a body comprising a flexible material having a plurality of adjustably sized notches therein, the body having a first longitudinal end..." Pierzina does not include a patient support surface as required by amended claim 21. Pierzina relates to a gun strap and does not disclose, teach or suggest a patient support surface as recited by amended claim 21.

Therefore, Applicants believe that amended claim 21 is in condition for allowance with respect to Pierzina. Removal of the rejection and allowance of claim 21 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

Claim 22

Claim 22 depends from claim 21. In that claim 21 is believed to be allowable, claim 22 is also believed to be allowable. Removal of the rejections and allowance of claim 22 is respectfully requested.

§ 102(b) in view of the Japanese Application

Applicants respectfully submit that the Japanese Application simply does not support the Examiner's rejection of claims 1-3, 5-12, 14, 15, 19-26 under 35 U.S.C. § 102(b) in light of the amendments to claims 7, 10, 11, 15, and 21.

The Japanese Application relates to a handrail configured to connect to a wall. The handrail includes segments and is attached to a wall for use with a stair case.

Claim 1

The Japanese Application fails to teach or suggest a combination including "a patient support surface, and a siderail having a siderail covering comprising a flexible body having a plurality of notches defined in the body..." as required by amended 1. The Japanese Application does not include a patient support surface as required by amended claim 1. The Japanese Application relates to a handrail for use with a wall and does not include a patient support surface as required by amended claim 1.

Therefore, Applicants believe that amended claim 1 is in condition for allowance with respect to the Japanese Application. Removal of the rejection and allowance of amended claim 1 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where each limitation is expressly disclosed.

Claims 2, 3, 5, 6, 8 and 9

Claims 2, 3, 5, 6, 8 and 9 depend from claim 1. In that claim 1 is believed to be allowable, claims 2, 3, 5, 6, 8 and 9 are also believed to be allowable. Removal of the rejections and allowance of claims 2, 3, 5, 6, 8 and 9 is respectfully requested.

Claim 7

The Japanese Application fails to teach or suggest a combination including "...the flexible body being able to flex so as to alter the size of the notches and defining a siderail channel therein adapted to receive a patient support siderail therein..." as required by amended 7. The Japanese Application does not include a patient support siderail as required by amended claim 7. The Japanese Application relates to a handrail for use with a wall and

does not include a siderail for use with a patient support or a patient support siderail as required by amended claim 7.

Therefore, Applicants believe that amended claim 7 is in condition for allowance with respect to the Japanese Application. Removal of the rejection and allowance of amended claim 7 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where each limitation is expressly disclosed.

Claim 10

The Japanese Application fails to teach or suggest a combination including "A siderail covering for a patient support siderail, the covering comprising a flexible body adaptable to cover a patient support siderail, the body having a plurality of notches defined in the body..." as required by amended 7. The Japanese Application does not disclose, teach or suggest a covering for use with a patient support siderail as recited in amended claim 7. The Japanese Application relates to a handrail for use with a wall and does not include a siderail covering for use with a patient support as required by amended claim 7

Therefore, Applicants believe that amended claim 10 is in condition for allowance with respect to the Japanese Application. Removal of the rejection and allowance of amended claim 10 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where each limitation is expressly disclosed.

Claim 11

The Japanese Application fails to teach or suggest a combination including "a patient support surface, and a siderail including a flexible body including a flexible material having a plurality of laterally extending apertures..." as required by amended claim 11. The Japanese Application does not disclose, teach or suggest a patient support surface as recited in amended claim 11. The Japanese Application relates to a handrail for use with a wall and does not include a patient support surface as required by amended claim 11.

Therefore, Applicants believe that amended claim 11 is in condition for allowance with respect to the Japanese Application. Removal of the rejection and allowance of claim 11 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

Claims 12-14

Claims 12-14 depend from claim 11. In that claim 11 is believed to be allowable, claims 12-14 are also believed to be allowable. Removal of the rejections and allowance of claims 12-14 is respectfully requested.

Claims 16 and 17 depend from allowable generic claim 11. Accordingly, Applicants submit that claims 16 and 17 are appropriate for consideration and are likewise in condition for allowance.

Claim 15

The Japanese Application fails to teach or suggest a combination including "A patient support siderail comprising[:] a flexible body including a flexible material having a plurality of laterally extending apertures..." as required by amended claim 15. The Japanese Application does not disclose, teach or suggest a patient support siderail as recited by amended claim 15. The Japanese Application relates to a handrail for use with a wall and does not include a patient support siderail as required by amended claim 15.

Therefore, Applicants believe that amended claim 15 is in condition for allowance with respect to the Japanese Application. Removal of the rejection and allowance of claim 15 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where the limitation is expressly disclosed.

Claim 21

The Japanese Application fails to teach or suggest a combination including "a patient support surface; and a siderail including a body comprising a flexible material having a plurality of adjustably sized notches..." as required by amended 21. The Japanese Application does not disclose, teach or suggest a patient support surface as recited by amended claim 21. The Japanese Application relates to a handrail for use with a wall and does not include a patient support surface as required by amended claim 21.

Therefore, Applicants believe that amended claim 21 is in condition for allowance with respect to the Japanese Application. Removal of the rejection and allowance of amended claim 21 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where each limitation is expressly disclosed.

Claims 22-26

Claims 22-26 depend from claim 21. In that claim 21 is believed to be allowable, claims 22-26 are also believed to be allowable. Removal of the rejections and allowance of claims 22-26 is respectfully requested.

§ 103(a) in view of Japanese Application in view of Campbell

Applicants respectfully submit that the combination of the Japanese Application and the Campbell patent is improper and therefore does not support the Examiner's rejection of amended claim 18 under 35 U.S.C. § 103(a). The case law is clear that in order for the U.S. Patent and Trademark Office to "establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." Manual of Patent Examining Procedure (M.P.E.P.) Section 2143.

It is well known that when combining the content of various references "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Raynes*, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Moreover, the Patent and Trademark Office can satisfy its burden of establishing obviousness "only by showing some *objective* teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teachings of the references." *In re Fine*, 1837 F.2d 1071, 1073, 5 USPQ2d 1596 (Fed. Cir. 1998) (emphasis added) (citations omitted). The Federal Circuit in *In re Fine* stated that a "bald assertion" of substituting an element in a prior art reference would have been within the ordinary skill in the art is insufficient to support a finding of obviousness." *Id.* at 1074.

The Federal Circuit has emphasized the requirement that the prior art must suggest the modifications necessary to achieve the claimed invention. The "mere possibility" that a prior art reference could be modified such that its use would lead to the particular result recited in

a claim does not make that recited in the claim obvious "unless the prior art suggested the desirability of such a modification." *In re Ochia*, 71 F.3d 1565, 1570, 37 USPQ2d 1127 (Fed. Cir. 1995). "Obviousness cannot be established by hindsight combination to produce the claimed invention." *In re Dunc*, 48 USPQ2d at 1637; *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

In the present case, there is simply no hint or suggestion to modify the handrail apparatus of the Japanese application to achieve the applicant's invention of claim 18 as amended.

As acknowledged by the Examiner, the Japanese Application does not "disclose or fairly suggest the flexible material of the body is made of foam." (Office Action, page 4 section 8). The Examiner further states that "in view of Cambell [sic], Jr. et al, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to replace the covering with the foam material in order to protect the object to be contacted with and enhance the softness of the rail covering." (Office Action, page 4 section 8).

The Examiner simply fails to satisfy the Patent and Trademark Office burden of establishing obviousness. Neither reference discloses, teaches or suggests a siderail for a patient support, including a flexible body adaptable to be coupled to a patient support, as recited in amended claim 18. The Examiner fails to show any objective teaching that would suggest modifying the Japanese Application in the manner claimed. The Campbell patent relates to foam bendable wire products for use in fields such as hair curlers, holders for ponytails, and the like. One of ordinary skill in the art field of patient support siderails would not be motivated to look to the art of bendable wires to arrive at the present invention. In other words, one of ordinary skill in the art of siderails would simply not be motivated to combine the Japanese Application's handrail with the bendable wire of Campbell to arrive at the claimed invention.

Therefore, Applicants believe that claim 18 is in condition for allowance with respect to the Japanese Application in view of Campbell. Removal of the rejection and allowance of claim 18 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where the teaching and motivation to modify the references as claimed is expressly disclosed in the references.

Appeal

To enable the Applicants to better respond to any potential remaining rejections on appeal, the Applicants respectfully request that the Examiner provide additional specificity

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for the rejections of the dependent claims. Without undue speculation or otherwise, the Applicants are unable to find support for the Examiner's rejections of at least claims 2-6, 8-9, 12-14, 19-20, and 22-26 in addition to the comments made above regarding the independent claims.

Final Remarks

In view of the foregoing amendments and remarks, Applicants submit that the application is now in condition for allowance. A Notice of Allowance is earnestly solicited.

If necessary, Applicants request that this Response be considered a request for an extension of time for a time appropriate for the response to be timely filed. Applicants request that any required fees needed beyond those submitted with this Response be charged to the account of Bose McKinney & Evans LLP, Deposit Account Number 02-3223.

Respectfully submitted,

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